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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/619,198 07/19/00 YAN

H MBHB00-422

EXAMINER

HM12/0927

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ART UNIT	PAPER NUMBER

1647

DATE MAILED:

09/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/619,198

Applicant(s)

Yan et al.

Examiner

Fozia Hamud

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 1, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5a, 6-13, drawn to an isolated polypeptide, an isolated polypeptide with at least one conservative amino acid substitution, a fusion protein, a composition comprising said polypeptide and a pharmaceutically acceptable carrier and said polypeptide which is covalently modified with a water soluble polymer, classified in class 530, subclass 399.
 - II. Claim 5b, 5e, drawn to an isolated polypeptide with at least one amino acid insertion, classified in class 530, subclass 399.
 - III. Claim 5c, 5e, drawn to an isolated polypeptide with at least one amino acid deletion, classified in class 530, subclass 399.
 - IV. Claim 5d, 5e, drawn to an isolated polypeptide which has a C-terminal truncation, classified in class 530, subclass 399.
 - V. Claim 5d, 5e, drawn to an isolated polypeptide which has an N-terminal truncation, classified in class 530, subclass 399.
 - VI. Claims 14-17, drawn to a method for treating a VGF polypeptide-related disease, classified in class 424, subclass 85.1
 - VII. Claim 18, drawn to a method of diagnosing a VGF polypeptide-related condition, classified in class 424, subclass 9.1.

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VIII. Claims 19-20, drawn, a method of identifying a compound which binds to polypeptide, classified in class 435, subclass 7.1.

IX. Claim 21, drawn, a device comprising a membrane for implantation and cells that secrete a polypeptide, class and subclass undeterminable, because the class and subclass would depend on the nature of the membrane, which is not known.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-V, IX are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The polypeptides of Group I-V and the device of Group IX are defined by different chemical and physical characteristics.

Inventions I-V and VI are related as products and process of use. However, the inventions are distinct because the polypeptides of Groups I-V as claimed can be used in materially different methods, such as in a method of raising antibodies, or can be used diagnostically.

Inventions I-V and VII are related as products and process of use. However, the inventions are distinct because the polypeptides of Groups I-V as claimed can be used in materially different methods, such as in a method of raising antibodies, or can be used therapeutically.

Inventions I-V and VIII are related as products and process of use. However, the inventions are distinct because the polypeptides of Groups I-V as claimed can be used in materially different methods, such as, they can be used diagnostically or therapeutically.

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Inventions VI-VIII are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different goals. The methods are distinct because each assay is performed for divergent purposes.

Inventions IX and VI-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the methods of Groups VI-VIII neither use nor produce the device of Group IX.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has prima facie shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

2. The claims of Groups I-IX are drawn to a multitude of polypeptides (SEQ ID NOs:1-10). This constitutes a recitation of an implied, mis-joined Markush group that contain multiple, independent and distinct inventions. Each of the polypeptides are independent and distinct because no common structural or functional properties are shared. Accordingly, these claims are subject to restriction under 35 U.S.C. 121.

Upon election of one of Groups I-IX, Applicant is additionally required to elect a single polypeptide. This requirement is not to be considered as a requirement of an election of species, since

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each of the compounds recited in alternative from is not a member of a single genus of invention, but constitutes an independent and patentably distinct invention.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Advisory Information

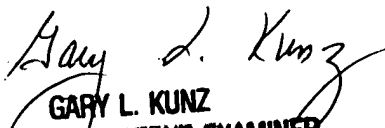
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday, Wednesday-Thursday from 7:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Fozia Hamud
Patent Examiner
Art Unit 1647
25 September 2001


GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600